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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,424	08/17/2001	Eric Eugene Johnson		4305

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EXAMINER

NELSON JR, MILTON

ART UNIT	PAPER NUMBER
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3636

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,424

Applicant(s)

JOHNSON, ERIC EUGENE

Examiner

Milton Nelson, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/17/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how the rigid head-support portion and the rigid base portion are included within a single inflatable structure, as set forth in claim 17. In claim 18, it is unclear how an inflatable structure forms when inflated, a rigid base portion, and includes a rigid head-support portion. Claims 19 and 20 are indefinite since each depends from an indefinite claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In independent claim 18, it is unclear if Applicant

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intends to positively claim the seat back. In line 1, the invention is set forth as a headrest adapted for detachably engaging the seat back of a chair. Such appears to set forth the seat back as only an environment with which to use the invention in. However, in lines 7-8, Applicant sets forth the head-support portion of the headrest as extending far enough outward from said seat back ... Such appears to set forth the seat back as part of the invention. Similarly note independent claim 21. In claim 21, also note "the back of said user's head rests not against said base portion, but substantially against the plane of said front surface of said seat back". In claim 18, "said user's" lacks proper antecedent basis. In claim 21 "the surface opposite from said base portion" lacks proper antecedent basis. In claim 13, it is unclear if "a means for wrapping" is intended to be the same structure as the "means for wrapping" previously set forth in claim 21, from which claim 13 depends. In claim 13, it is unclear if "said back of said seat back" is intended to be the previously set forth "rear surface" of the seat back, as set forth in claim 21 from which claim 13 depends. In claim 13, "the two ends of said straps" lack proper antecedent basis.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rigid head-support and base portions in combination with an inflatable structure must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 13 and 16, as best understood with the above cited indefiniteness, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickey et al (4619483) in view of Franzen, Jr. (5685613).

The primary reference shows all claimed features of the instant invention with the exception of the means for wrapping around the front and rear surfaces of the seat back (claim 21); wherein the means for wrapping comprising two straps, wherein the two ends of the straps being attachable together with a length-adjustable buckle (claim 13). Note the base portion (32) and head-support portion (46).

The secondary reference conventionally teaches configuring a support with a means for wrapping, wherein the means for wrapping comprises two straps, wherein the two ends of the straps being attachable together with a length-adjustable buckle. Note such in Figure 17.

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It would have been obvious to one having ordinary skill in the pertinent art at the time of the instant invention to modify the primary reference in view of the teachings of the secondary reference by replacing the attachment means of the primary reference with a means for wrapping, wherein the means for wrapping comprises two straps, wherein the two ends of the straps are attachable together with a length-adjustable buckle. Such a modification enhances selective securement of the device to a supporting object.

Allowable Subject Matter

Claims 12, 14 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Amendment/Arguments

Applicant's response filed October 6, 2003 has been fully considered. Remaining issues are detailed in the above sections. The objections under 35 U.S.C. 112, first paragraph remain. Applicant argues that the originally filed drawings and specification adequately describe the invention to enable one skilled in the art to make and/or use the invention. The examiner disagrees with these arguments for the reasons set forth in the objections under 37 CFR 1.83(a) and 35 U.S.C. 112, first paragraph. Applicant argues that the head-support and base portions are not independent parts of the inflatable embodiment, but are in both structure and function embraced by and

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comprised within a single inflatable component of appropriate shape, as indicated in the specification and drawings. The drawings fail to show such a structure. It is not clear how the structure is both rigid and inflatable. The specification fails to adequately teach such a structure.

35 U.S.C. 112, second paragraph objections remain in the application as discussed in the pertinent section above.

The 37 CFR 1.83(a) objection remains. The drawings fail to show rigid head-support and base portions in combination with an inflatable structure. Applicant indicates that the head-support portion is shown at 14, and the base portion is shown at 15, within an inflatable structure 36. Figures 7 and 7A merely show a tear shaped object with straps and buckles. Characters 14 and 15 appear directed simply to areas of the singular, unitary, tear-drop shaped, inflatable structure. The only structure that appears rigid would be the buckles.

Regarding application of Dickey to the claims, Applicant argues that the prior art device cannot be used at all without the shoulder support also being attached to the chair. The shoulder support in Dickey serves as a means for attachment to the chair. Applicant argues that the instant invention is distinct in that it may be releasably attached directly to the seat back of a chair without any extra bulk, such as a shoulder support. This argument appears more limiting than the claim language. Applicant argues that head support portion (46) is a hip bolster and not a head support. In lines 38-40 of column 4, Dickey identifies member 46 (of the member 50) as being identical

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to member 46 (of the member 44). Clearly member 46 (of the member 50) represents a head support portion.

Applicant further argues that the right angle orientation of the base portion and the head support portion, as set forth in claim 16, is lacking. Note that the head support portion extends horizontally, wherein the base portion extends vertically at a right angle to the head support portion.

Regarding claim 12, the combination presented therein appears to overcome the prior art of record. Applicant's arguments are persuasive.

Regarding claim 13, it would have been obvious to substitute the straps of Franzen for the reasons indicated in the pertinent section above. Use of straps to attach a cushion to supporting object is old and well known in the art.

All remaining rejections and objections are proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

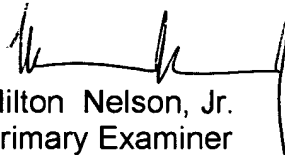
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milton Nelson, Jr. whose telephone number is 7033082117. The examiner can normally be reached on Monday-Friday 5:30-3:00.

The fax phone number for the organization where this application or proceeding is assigned is 7033053597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 7033082168.



Milton Nelson, Jr.
Primary Examiner
Art Unit 3636

mn
December 29, 2003